

### **REMARKS/ARGUMENTS**

The Office Action mailed March 30, 2004 has been reviewed and carefully considered. Claims 3 and 8 are canceled. Claims 1, 2, 4, 5, 6, and 7 have been amended. Claims 1-2, 4-7, and 9 are pending in this application, with claims 1 and 5 being the only independent claims. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

In the Office Action mailed March 30, 2004, claims 1, 2, 4-7, and 9 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,966,653 (Joensuu).

Claims 3 and 8 stand rejected under 35 U.S.C. §103 as unpatentable over Joensuu in view of WO97/19548 (Merchant).

Before discussing the cited prior art and the Examiner's rejections of the claims in view of that art, a brief summary of the present invention is appropriate. The present invention relates to a method and system for setting up a telecommunication connection between an A-party located in a first country and a B-party located in a second country while avoiding the problem of unequal, direction dependent charges for inter-country calls (see page 2, lines 8-20, and page 4, lines 3-5 of the specification). According to the inventive method, the A-party sends a call-back connection setup message from the A-party's telecommunication terminal to a telecommunication server connected to the mobile subscriber network, wherein the telecommunication server includes means for handling calls and messages (see page 4, lines 9-15, and page 7, lines 9-14). The telecommunication server identifies the B-party from the call setup message and sets up a first call to the A-party and a second call to the B-party (page 4, lines 15-17, and page 7, line 20 to page 8, line 1). The telecommunication server then connects the two calls to establish a telecommunication

connection between the A-party and the B-party so that a communication connection or call is established from the B-party to the A-party (page 4, lines 17-18, and page 8, lines 1-2).

Each of the independent claims 1 and 5 recites that a telecommunication connection is established from the B-party telecommunication terminal to the A-party telecommunication terminal based on a call-back connection setup message received from the A-party. Furthermore, each of the independent claims 1 and 5 has been amended to specifically recite that a call-back connection is set up. In addition, independent claims 1 and 5 have been amended to include the limitations of now-cancelled dependent claims 3 and 8, respectively, and now recite that the A-party subscription is determined and charges are directed to the A-party subscription for the call from the B-party telecommunication terminal to the A-party telecommunication. Since the amendments emphasize that the message is a call-back connection setup message, which was already indicated in the original claims, and incorporate limitations of now-cancelled dependent claims, the amendments do not require further search and/or consideration. Accordingly, these amendments are allowable under 37 CFR 1.116 and it is respectfully requested that the amendments be entered.

Joensuu discloses a method and device for validating a forward-to-number within a mobile telecommunication system for call forwarding. According to Joensuu, a mobile station 80 requests activation of a call forwarding variable (CFV) toward a wireline terminal 70 using an unstructured supplementary service data (USSD) message which is sent to a mobile switching center (MSC) (see col. 4, lines 56-62 of Joensuu). The message may include a request to validate the call forward number, in which case either a speech call is made to the wireline terminal 70 (col. 5, lines 50-66) or a transaction capabilities application part (TCAP) application layer signal is sent to the local exchange (LE) 60 of the wireline terminal 70 (col. 6, lines 59-64). Since Joensuu relates to call forwarding, Joensuu fails to disclose sending a call-back connection setup message, as recited

in independent claims 1 and 5. Joensuu also fails to disclose or suggest establishing a connection from a B-party terminal to an A-party terminal in response to a message initiated by an A-party terminal, as recited in independent claims 1 and 5 (i.e., a reverse call). In contrast, Joensuu discloses that a validation call is made from the A-party terminal (mobile terminal 80) to the B-party terminal associated with the call forward number (wireline terminal 70), in response to a message initiated by the A-party terminal. Joensuu also fails to disclose that the A-party terminal and the B-party terminal are in different countries, as is recited in independent claims 1 and 5.

For all the above reasons, it is respectfully submitted that independent claims 1 and 5 are not anticipated by Joensuu under 35 U.S.C. §102. Furthermore, since Joensuu is directed to details of a call forwarding service, Joensuu fails to provide any teaching or suggestion for establishing a call-back connection from a B-party terminal to an A-party terminal in response to a call-back connection setup request from the A-party terminal, as is expressly recited in independent claims 1 and 5. Accordingly, independent claims 1 and 5 are also allowable over Joensuu under 35 U.S.C. §103.

Independent claims 1 and 5 are additionally allowable over Joensuu in view of Merchant because (1) there is no motivation to one skilled in the art to combine the teachings of Joensuu and Merchant, and (2) the combined teachings of Joensuu and Merchant fail to teach or suggest the claimed invention.

With respect to motivation, a *prima facie* case of obviousness requires that the suggestion or motivation for combining the references must be found in the references themselves or in the knowledge available to those skilled in the art (MPEP §2143). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Merchant discloses a reverse call origination scheme (see page 5, lines 6-15). However, Merchant discloses that a call setup message is sent to a U.S. service provider using a non-signaling network such as the Internet and that the call is subsequently made by a U.S. operator using the signaling network (see page 5, lines 16-23, and Figs. 1 and 2). More specifically, Merchant discloses that a U.S. operator calls the called party in the U.S. and then calls the calling party (page 9, lines 8-12). The calling party's card is then billed for the two call legs as two separate calls (page 9, line 19). As described in the background section of Merchant, the Merchant reference specifically teaches sending the message to the reverse call setup (call-back connection setup) via a non-signaling network such as the internet in order to avoid using the telecommunication network and thereby minimize use of the resources of the telecommunication network during setup.

It is respectfully submitted that there is no motivation to combine the teachings of Joensuu, which relates to call forwarding, with the teachings of Merchant which relates to call-back connection from a B-party terminal to an A-party terminal. These references respectively relate to two separate and distinct services of telecommunication networks.

Furthermore, Merchant teaches and instructs that the setup message is sent using a non-signaling network such as the internet for the express purpose of reducing the use of telecommunication resources during setup. Accordingly, there is no motivation to combine the teachings of Joensuu, which uses the telecommunication network to transmit the setup request message, with the teachings of Merchant. Thus, a *prima facie* rejection has not been established and independent claims 1 and 5 should be allowable for at least this reason.

As to the combined teachings of these references, independent claims 1 and 5 recite "identifying, at the telecommunication server, a subscription of the A-party" and "directing, to the A-party subscription, call charges for the telecommunication connection from the B-party telecommunication terminal to the A-party telecommunication terminal". Joensuu fails to disclose, teach or suggest the call-back connection scenario as recited in the independent claims and therefore fails to teach or suggest the above recited limitations regarding how the charges are directed. In contrast to the present invention, Joensuu discloses that the party from which the call is made is charged for the call. Merchant discloses a call-back connection but fails to teach or suggest charging an A-party subscription for a call from a B-party terminal to an A-party terminal. Instead of determining an A-party subscription, Merchant teaches that the A-party must provide billing information, such as a card to which the charges are to be directed (page 8, lines 2-3 and lines 25-26). Accordingly, neither Merchant nor Joensuu disclose, teach or suggest identifying, by the telecommunication server, an A-party subscription, as is recited in independent claims 1 and 5.

As noted above, Merchant discloses sending the call-back connection setup message using a non-signaling network, such as the internet, to reduce the use of the telecommunication network resources during setup. Since Merchant requires the use of a non-signaling network, such as the Internet, to send the call setup message, Merchant teaches away from sending the call setup message using a switched telecommunication network, as is recited in independent claims 1 and 5. Accordingly, it is respectfully submitted that independent claims 1 and 5 are allowable over Joensuu in view of Merchant.

Dependent claims 2, 4, 6-7, and 9, being dependent on independent claims 1 and 5, are deemed allowable for at least the same reasons expressed above with respect to independent claims 1 and 5.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By

A handwritten signature in black ink, appearing to read 'Lance J. Lieberman', is written over a horizontal line.

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